



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/768,766	01/30/2004	Jerome Agnola	770P011330-US (PAR)	7047

7590 04/05/2007
Kenyon & Kenyon LLP
1500 K Street, NW
Washington, DC 20005-1257

EXAMINER

LIU, ERIC

ART UNIT	PAPER NUMBER
----------	--------------

3628

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/05/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No. 10/768,766	Applicant(s) AGNOLA ET AL.	
	Examiner Eric Liou	Art Unit 3628	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 January 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>7/26/04 and 1/27/06</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Priority

1. The Examiner has given consideration to applicant's Provisional Application No. 60/469,978 filed on 5/13/03. For examining purposes of this application, the effective filing date will be 5/13/03.

Drawings

2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: Figure 1: "112", Figure 2: "240" and "244", Figure 3: "316" and "318", and Figure 4: "410" and "412". Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

3. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: "108" (paragraph 00016) and "407" (paragraph 00033). Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any

Art Unit: 3628

amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

4. The drawings are objected to because reference numbers "404" drawn to a network (paragraph 00032) and "406" drawn to a data storage device (paragraph 00033) appear to be labeled incorrectly in Figure 4. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

7. Claim 1 recites the limitation “at least one removable user interactive display coupled to the franking machine, then at least one removable display including a wireless connection...” It is unclear whether the at least one removable user interactive display coupled to the franking machine is the same device as the at least one removable display including a wireless connection. The Examiner is interpreting the two devices to be the same.

8. Claim 4 recites the limitation “the franking machine” in line 3. There is insufficient antecedent basis for this limitation in the claim.

9. Claim 9 recites the limitation “information related to the funds is transferred from the portable display to the franking machine when the portable display is reinserted into the franking machine.” It is unclear what the result is when the portable display is not reinserted into the franking machine.

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

Art Unit: 3628

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

11. Claims 1 and 11 are rejected under 35 U.S.C. 102(e) as being anticipated by Coffy et al., U.S. Patent No. 6,920,557.

12. As per claim 1, Coffy teaches a mail processing system comprising: a franking/postage machine (Coffy: Figure 1A, "10" and column 3, lines 51-52); at least one removable user interactive display coupled to the franking machine (Coffy: Figure 1A, "40"), then at least one removable display including a wireless connection for wireless communication between the removable display and the franking machine when the removable display is physically disconnected from the franking machine (Coffy: Figure 1A, "40" and column 3, lines 29-32).

13. As per claim 11, Coffy teaches a computer program product comprising: a computer useable medium having a computer readable code means embodied therein for causing a computer to manage multiple activities in a mailroom by using a portable display of a franking machine to operate other mail processing devices (Coffy: column 6, lines 9-11 and column 3, lines 29-32), the computer readable code means in the computer program product comprising: computer readable program code means for causing a computer to activate a second display of the franking machine when the portable display is removed from the franking machine (Coffy: column 4, lines 26-44); computer readable program code means for causing a computer to maintain a wireless communication connection between the portable display, the franking machine and other mail processing devices in the mailroom (Coffy: column 3, lines 29-32); and computer readable program code means for causing a computer to enable the portable display to

Art Unit: 3628

interface with and operate the other mail processing devices in the mailroom while the franking machine is franking mail pieces (Coffy: column 4, lines 36-43 and column 5, lines 39-45).

Claim Rejections - 35 USC § 103

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. Claims 2-4 and 6-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Coffy et al., U.S. Patent No. 6,920,557.

16. As per claim 2, Coffy teaches in a first embodiment the mail processing system of claim 1 as described above. Coffy does not teach the franking machine includes a second graphical user interface that is activated when the removable display is in an undocked operating mode in the first embodiment.

17. Coffy teaches in a second embodiment the franking machine includes a second graphical user interface that is activated when the removable display is in an undocked operating mode (Coffy: Figure 2A, "120", column 3, lines 54-56, and column 4, lines 26-28).

18. It would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to have modified the first system embodiment of Coffy to have included the franking machine includes a second graphical user interface that is activated when the removable display is in an undocked operating mode as taught by the second embodiment of Coffy for the

Art Unit: 3628

advantage of providing wireless network devices that allow portable computers to access a mailing network in order to minimize the inconveniences of a crowded mailroom environment (Coffy: column 3, lines 13-27).

19. As per claim 3, Coffy teaches the mail processing system of claim 2 as described above. Coffy further teaches the at least one removable display comprises a personal digital assistant (Coffy: Figure 1A, "40").

20. As per claim 4, Coffy teaches in a first embodiment a method for managing mail processing activities in a mailroom comprising: activating a second display associated with the franking machine (Coffy: Figure 1A, "40", column 3, lines 29-32 and 54-56);

21. Coffy does not teach removing a portable display of the franking machine from the franking machine and using the portable display to operate another function in the mailroom related to the mail processing activities other than the franking machine, while the franking machine is franking mail pieces in the first embodiment.

22. Coffy teaches in a second embodiment removing a portable display of the franking machine from the franking machine (Coffy: Figure 2A and column 4, lines 26-28) and using the portable display to operate another function in the mailroom related to the mail processing activities other than the franking machine, while the franking machine is franking mail pieces (Coffy: column 4, lines 36-43, "the external wireless user interface will provide the user interface and processing function of 290.", and column 5, lines 39-45 – The Examiner notes, the wireless user interface has access to wireless scales. It would be obvious to use the user interface to operate the wireless scales remotely for the advantage of minimizing the inconveniences of a crowded mailroom environment.).

Art Unit: 3628

23. It would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to have modified the first embodiment of Coffy to have included removing a portable display of the franking machine from the franking machine and using the portable display to operate another function in the mailroom related to the mail processing activities other than the franking machine, while the franking machine is franking mail pieces as taught by the second embodiment of Coffy for the advantage of providing wireless network devices that allow portable computers to access a mailing network in order to minimize the inconveniences of a crowded mailroom environment (Coffy: column 3, lines 13-27).

24. As per claim 6, Coffy teaches the method of claim 4 as described above. Coffy further teaches using the portable display to meter outgoing mail (Coffy: column 4, lines 36-45 and Figure 4, "440").

25. As per claim 7, Coffy teaches the method of claim 4 as described above. Coffy further teaches arranging for a shipment of mailpieces via a commercial carrier using the portable display (Coffy: column 4, lines 36-44, The Examiner interprets the use of the mailing machine controller functions to be arranging for a shipment of mailpieces. The Examiner notes, it is basic knowledge of one skilled in the art to recognize that mailpieces can be shipped by commercial carriers. The applied reference has been interpreted and applied assuming basic knowledge of one of ordinary skill in the art. According to *in re Jacoby*, 135 USPQ 317 (CCPA 1962), the skilled artisan is presumed to know something more about the art than only what is disclosed in the applied references. In *In re Bode*, 193 USPQ 12 (CCPA 1977), every reference relies to some extent on knowledge of persons skilled in the art to complement that, which is disclosed therein.).

26. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Coffy et al., U.S. Patent No. 6,920,557 in view of Barta et al., U.S. Patent No. 6,634,551.

27. As per claim 5, Coffy teaches the method of claim 4 as described above. Coffy further teaches using the portable display to scan a bar code (Coffy: column 5, line 15). Coffy does not teach scanning incoming packages and mail for identifier information.

28. Barta teaches scanning incoming packages and mail for identifier information (Barta: column 4, lines 2-5).

29. It would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to have modified the method of Coffy to have included scanning incoming packages and mail for identifier information as taught by Barta for the advantage of providing an improved method for delivering parcels or other similar items which is reliable and efficient. (Barta: column 2, lines 35-41).

30. Claims 8-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Coffy et al., U.S. Patent No. 6,920,557 in view of Liechti et al., U.S. Patent No. 5,715,164.

31. As per claim 8, Coffy teaches the method of claim 4 as described above. Coffy further teaches establishing a link between the portable display and another entity (Coffy: Figure 1A and column 4, lines 25-44); transferring data to the portable display (Coffy: Figure 1A and column 4, lines 25-44); and transferring data from the portable display to the franking machine (Coffy: Figure 1A and column 4, lines 25-44).

Art Unit: 3628

32. Coffy does not teach replenishing funds for the franking machine to print postal indicia by establishing a telemeter setting link with a funds provider and data related to the funds.

33. Liechti teaches replenishing funds for the franking machine to print postal indicia by establishing a telemeter setting link with a funds provider and data related to the funds (Liechti: column 5, lines 12-32, The Examiner interprets the user's creditworthiness to be data related to the funds since it is used to adjust the postage amount limit.).

34. It would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to have modified the method of Coffy to have included replenishing funds for the franking machine to print postal indicia by establishing a telemeter setting link with a funds provider and data related to the funds as taught by Liechti for the advantage of controlling the amount of credit extended to the user (Liechti: column 5, lines 27-31).

35. As per claim 9, Coffy in view of Liechti teaches the method of claim 8 as described above. Coffy further teaches information is transferred from the portable display to the franking machine (Coffy: Figure 1A and column 4, lines 25-44). Liechti further teaches information related to the funds is transferred to the franking machine (Liechti: column 5, lines 22-32, The Examiner notes, The USPTO interprets claim limitations that contain "*if, may, might, can, when and could*" statement(s), as optional language. As matter of linguistic precision, optional claim elements do not narrow claim limitations, since they can always be omitted (In re Johnston, 77 USPQ2d 1788 (CA FC 2006)). Language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation.).

Art Unit: 3628

36. It would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to have modified the method of Coffy to have included information related to the funds is transferred to the franking machine as taught by Liechti for the advantage of controlling the amount of credit extended to the user (Liechti: column 5, lines 27-31).

37. As per claim 10, Coffy in view of Liechti teaches the method of claim 8 as described above. Coffy further teaches information is transferred from the portable display to the franking machine over a wireless communication link (Coffy: column 4, lines 25-44). Liechti further teaches information related to funds is transferred to the franking machine (Liechti: column 5, lines 22-32).

38. It would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to have modified the method of Coffy to have included information related to the funds is transferred to the franking machine as taught by Liechti for the advantage of controlling the amount of credit extended to the user (Liechti: column 5, lines 27-31).

Conclusion

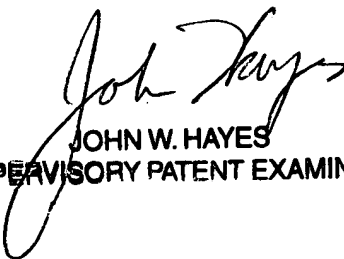
The Examiner has cited particular portions of the references as applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested that the applicant, in preparing the responses, fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Art Unit: 3628

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eric Liou whose telephone number is 571-270-1359. The examiner can normally be reached on Monday - Friday, 8:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Hayes can be reached on 571-272-6708. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


JOHN W. HAYES
SUPERVISORY PATENT EXAMINER